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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,666	03/29/2004	Michael J. Mitrovich	MITM103	3579
7590	04/19/2006		EXAMINER	
STEPHEN M. NIPPER DYKAS, SHAVER & NIPPER, LLP PO BOX 877 BOISE, ID 83701-0877			KIM, CHONG HWA	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,666	MITROVICH, MICHAEL J.	
	<b>Examiner</b> Chong H. Kim	<b>Art Unit</b> 3682	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 23 January 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke et al., U.S. Patent 5,337,860.

Burke et al. shows, in Figs. 1-7, a right rectangular parallelepiped lubricant stick, the stick 82 having a first end extending to second end, the first end for contacting a surface to be lubricated, the second end for contacting a constant force spring 94 of a lubricant applicator, the constant force spring for holding the first end against the surface to be lubricated, the constant force spring comprising a first portion 90 extending to a coiled second portion 94, the first portion configured to attachment to the lubricant applicator, wherein the second end defines therein a channel (as shown in Fig. 7 near where reference number 82 is pointing) for receiving at least a portion of the coiled second portion; wherein the right rectangular parallelepiped lubricant stick further having a first face opposite a second face (the faces facing each other across the channel), wherein the channel is generally right rectangular parallelepiped shaped, extending through both the first and second faces.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szatkowski et al., U.S. Patent 5,251,724 in view of Bitdinger et al., U.S. Patent 5,478,316.

Szatkowski et al. shows, in Figs. 1-15, a right rectangular parallelepiped lubricant stick and coiled constant force spring combination for lubricating a surface, the combination configured for utilization with a lubricant applicator, the spring having a coiled portion, the combination comprising: a lubricant stick 108 having a stick first end extending to a stick second end, the stick first end, for contacting the surface, the stick second end for cooperating with a constant force spring 110, thereby applying a constant force holding the stick upon the surface to be lubricated, the spring having a spring first end 114 extending to a spring second end 116, the first end comprising an attachment for attaching to the lubricator, the portion of the spring extending from the spring first end to the spring second end coiled, wherein as the lubricant stick is dispensed via the lubricant applicator the lubricant stick shortens and the spring coils thereby applying a constant force holding the lubricant stick first end against the surface, wherein the lubricant stick further having a first face opposite a second face, but fails to show a channel formed at the second end of the lubricant stick.

Bitdinger et al. teaches, in Fig. 19, a constant force spring 56 that applies a constant force on a rectilinearly moveable device 46 and is held in a channel 48.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the lubricant stick end of Szatkowski et al. with the spring received channel as taught by Bitdinger et al. in order to provide a better engagement between the spring and the lubricant stick so that the urging of the stick on to the surface remains constant.

As to the matter of the channel being in different shapes as recited in claims 3-6 and 9-12, it would have been obvious to a person of ordinary skill in the art to modify the shape of the channel to such different shapes, since applicant has not disclosed that having the channel shaped in either semi-cylindrical, or prismatic, or semi-hexagonal solves any stated problem or is for any particular purpose and it appears that the stick would perform equally well with the channel formed at any shape as long as the channel is utilized to hold the spring in place.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkerhoff, U.S. Patent 282,837 in view of Szatkowski et al., U.S. Patent 5,251,724.

Brinkerhoff shows, in Figs. 5, 6, and 8, a lubricant stick and coiled spring combination for lubricating a surface, the combination comprising a lubricant stick C having a channel for receiving a spring and hold the spring therewith and wherein the lubricant stick further having a first face and opposite a second face (both face being on the inside surface of the channel), wherein the channel is a generally right rectangular parallelepiped shaped extending through the first and second faces, but fails to show a constant force spring.

Szatkowski et al. shows, in Figs. 1-15, a right rectangular parallelepiped lubricant stick and coiled constant force spring combination for lubricating a surface, the combination

configured for utilization with a lubricant applicator, the spring having a coiled portion, the combination comprising: a lubricant stick 108 having a stick first end extending to a stick second end, the stick first end, for contacting the surface, the stick second end for cooperating with a constant force spring 110, thereby applying a constant force holding the stick upon the surface to be lubricated.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the spring of Brinkerhoff with the constant force spring as taught by Szatkowski et al. in order to provide a better and more constant engagement between the surface and the lubricant stick so that a better lubrication can be realized.

As to the matter of the channel being in different shapes as recited in claims 4-6 and 10-12, it would have been obvious to a person of ordinary skill in the art to modify the shape of the channel to such different shapes, since applicant has not disclosed that having the channel shaped in either semi-cylindrical, or prismatic, or semi-hexagonal solves any stated problem or is for any particular purpose and it appears that the stick would perform equally well with the channel formed at any shape as long as the channel is utilized to hold the spring in place.

#### *Response to Arguments*

6. In response to applicant's argument that Burke et al. fails to show the lubricant stick having a second end **for** contacting a constant force spring and defining therein a channel **for** receiving at least a portion of the coiled second portion, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Burke et al. shows the lubricant stick 82 having the second end that is capable of contacting a constant force spring of a lubricant applicator. Even if the intended use language is interpreted to be a positive recitation, the pull guide 96 is a part of the constant force spring. Therefore it can be construed that the constant force spring is in direct contact with the lubricant stick.

Also, Burke et al. shows, a channel (as shown in Fig. 7 near where reference number 82 is pointing) formed on the second end of the lubricant stick that is capable of being used for receiving at least a portion of the coiled second portion.

7. Applicant's argument, with respect to claim 1 recitation of the limitation "constant force spring" must be given patentable weight for it is being positively recited, has been fully considered and is persuasive. The rejection under 35 USC 102 of claims 1-3 by Brinkerhoff has been withdrawn.

8. In response to applicant's argument that the lubricant stick of Brinkerhoff is not the same lubricant stick in the present invention, it is the Examiner's view that the Brinkerhoff's lubricator can be construed to be a lubricant stick. There is no clear definition as to what it means by a "lubricant stick". It appears that if the lubricating device looks like an elongated stick and used for transferring lubricant, then it can be construed to be a "lubricant stick". There is no set standard that the definition of the "lubricant stick" must include the material that acts like a "wax" or "eraser" or "graphite" in which the material becomes "worn" over the time. Even if the definition must include such material, it appears that Brinkerhoff's lubricator C is made of a

material that is capable of becoming “worn” over the time of usage since the lubricator C is in constant contact with the surface A’ by the urging of the spring D. Therefore, the lubricator of Brinkerhoff can be construed to be the lubricant stick as recited in the claims.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the knowledge generally available to one of ordinary skill in the art. As discussed above in the rejection, in paragraph 4, the motivation for modifying the lubricant stick end of Szatkowski et al. with the spring received channel as taught by Bitdinger et al. is to provide a better engagement between the spring and the lubricant stick so that the urging of the stick on to the surface remains constant.

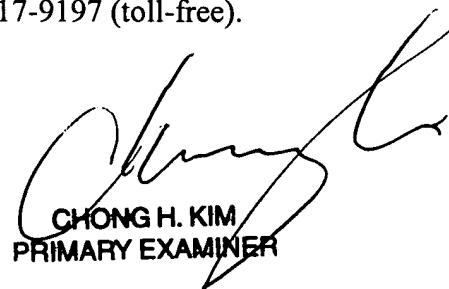
10. In response to applicant's argument that Bitdinger et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bitdinger et al. shows the constant force spring 56 that applies a constant force on a rectilinearly moveable device 46 (like the lubricant stick) by being held in a channel 48 form on the end of the device 46. Such structure is reasonably pertinent to the particular problem with which the applicant was concerned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (571) 272-7108. The examiner can normally be reached on Monday - Friday; 6:00 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chk  
April 14, 2006



CHONG H. KIM  
PRIMARY EXAMINER